

REMARKS

By this Amendment, Applicants amend claims 1 and 19-23 to more appropriately describe Applicants' invention, and cancel claims 2-12 and 18 without prejudice or disclaimer of the subject matter thereof. Claims 1, 13-17, and 19-23 are now pending in this application.

In the Office Action,¹ the Examiner rejected claims 1-8 and 10-20 under 35 U.S.C. § 102(e) as anticipated by Tamano et al. (U.S. Patent No. 6,032,157) and rejected claims 9 and 21-23 under 35 U.S.C. § 103(a) as obvious over Tamano in view of DeLorme et al. (U.S. Patent No. 5,848,373).

I. REJECTION OF CLAIMS 1-8 AND 10-20 UNDER § 102(e)

Applicants respectfully traverse the rejection of claims 1-8 and 10-20 under 35 U.S.C. § 102(e) as anticipated by Tamano. To properly anticipate Applicants' claimed invention, the Examiner must demonstrate the presence of each and every element of the claim in issue, either expressly described or under principles of inherency, in a single prior art reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." See M.P.E.P. § 2121 (8th ed., Aug. 2001), *quoting Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Finally, "[t]he elements must be arranged as required by the claim." M.P.E.P. § 2131 (8th ed. 2001), p. 2100-69.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Claim 1, as amended, recites a method of manipulating a map including, among other things, “converting first map coordinates designating the boundary of the geographic region selected on the first map into geographic coordinates using a georeferencing function of the first map” and “converting the geographic coordinates to corresponding second map coordinates designating the boundary of the geographic region on the second map using a georeferencing function of the second map.”

Tamano does not teach a method including at least these steps. Since Tamano does not teach each and every element of claim 1, it cannot anticipate claim 1.

By contrast, the Tamano system refers to image information linked with attribute information as first image information, and information that approximately corresponds to the first image information as second image information, which is not linked to the attribute information. See Tamano, col. 2, lines 41-52. Using an object contained in the second image information as a key, the Tamano system retrieves the attribute information linked with the first image information by inputting a correspondence between the second image information and the first image information via the key, i.e., by selecting an object in the second image information. See Tamano, col. 2, lines 41-52. Tamano also discloses one may “choose a part in the first image information 1 and a part in the second image information 2 so that these parts can be linked to each other” in connection with Figs. 11(a) through 11(e), which correspond to Figs. 10(a) through 10(e). See col. 8, lines 34-53. Tamano, however, does not disclose at least “converting first map coordinates designating the boundary of the geographic region selected on the first map into geographic coordinates using a georeferencing function of the first map” and “converting the geographic coordinates to corresponding second map coordinates

designating the boundary of the geographic region on the second map using a georeferencing function of the second map,” as recited in amended claim 1.

Claim 1 is thus allowable over Tamano and claims 13-19 are allowable at least due to their dependence from claim 1. Independent claim 20, although of a different scope from claim 1, includes recitations similar to that of claim 1. For at least the same reasons discussed above in relation to allowable claim 1, Applicants respectfully request the Examiner to allow claim 20.

Since Applicants have canceled claims 2-12, the rejection with regard to these claims is moot.

II. REJECTION OF CLAIMS 9 AND 21-23 UNDER § 103(a)

Applicants respectfully traverse the rejection of claims 9 and 21-23 under 35 U.S.C. § 103(a) as unpatentable over Tamano in view of DeLorme. To establish a proper *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must meet each of the following three requirements. First, the reference taken alone, or references combined, must teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143.03 (8th ed. 2001). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See M.P.E.P. § 2143.01 (8th ed. 2001). Third, a reasonable expectation of success must exist. See M.P.E.P. § 2143.02 (8th ed. 2001). Moreover, each of these requirements must be found in the prior art, and not be based on applicant's disclosure. See M.P.E.P. § 2143 (8th ed. 2001).

As discussed above, Tamano does not disclose or suggest all of the elements of claim 1. Claims 21-23, while of a different scope from each other and claim 1, include recitations similar to claim 1, and are thus distinguishable over Tamano for reason discussed above in regard to claim 1. While DeLorme discloses a computer aided map location system that provides correlation and coordination of spatially related data between a computer and a set of printed maps, DeLorme does not make up for the deficiencies of Tamano discussed above. In particular, DeLorme at least fails to disclose or suggest “converting first map coordinates designating the boundary of the geographic region selected on the first map into geographic coordinates using a georeferencing function of the first map” and “converting the geographic coordinates to corresponding second map coordinates designating the boundary of the geographic region on the second map using a georeferencing function of the second map,” as recited in claim 21. As noted, claims 22 and 23 recite limitations similar to those recited in claim 21. Accordingly, claims 21-23 are allowable over the Examiner’s proposed combination of Tamano and DeLorme.

Since Applicants have canceled claim 9, the rejection with regard to this claim is moot.

CONCLUSION

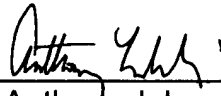
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 10, 2005

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